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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,441	05/10/2000	LASZLO BALAZS	1060-136P	1924

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/10/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/485,441

Applicant(s)
BALAZS et al.

Examiner
Brenda Coleman

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1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 6, 2002 and May 24, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, and 17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13, 14, 16, and 17 is/are rejected.
- 7) ☒ Claim(s) 4 and 12 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Claims 1-14, 16 and 17 are pending in the application.

This action is in response to applicant's amendments dated May 6, 2002 and May 24, 2002. Claims 1, 2, 9, 10, 16 and 17 have been amended.

Note in the amendment filed May 6, 2002, the applicants indicated that no claims have been canceled or added and that claims 1-17 are pending in the application. However, the amendment filed April 8, 2002 canceled claim 15 and thus the pending claims are 1-14, 16 and 17.

Response to Arguments

Applicant's arguments filed May 6, 2002 and May 24, 2002 have been fully considered with the following effect:

1. With regards to the 35 USC § 112, second paragraph rejection labeled 2b) maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants' stated that they have addressed and overcome all rejections. However, the phrase "which latter is optionally substituted" within the definition of R⁷ and R⁸ has only been amended to remove "latter" from the definition of R⁷ and R⁸ in claim 9. The applicants' attention is drawn to the definition of R⁷ and R⁸ on page 8 of the amendment where R⁷ and R⁸ form together with the adjacent nitrogen atom, an oxopyrrolidinyl group, a phthalimido group **which is optionally substituted**... There is no indication what the substituents are for the phthalimido and thus the definition of R⁷ and R⁸ is vague and indefinite as to the number and nature of the substituents.

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Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons of record and stated above.

2. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 1-3, 5-7, 9, 10, 13, 14, 16 and 17 by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that they have addressed and overcome all rejections. However, the proviso of the instant invention is such in claims 1, 16 and 17 that R is other than a chlorine atom. However, this proviso is not present in the composition claim. Andrási teaches compounds **for example** where R is Cl.

Claim 9 is rejected under 35 U.S.C. § 102(b) as being anticipated by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

3. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1, 5-9 and 13-17 by Hamori et al., WO 96/04283 (U.S. equivalent 5,756,495) of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants' stated that the "present invention is patentable over the cited art as the present invention has superior and unexpected effects over the prior art compounds". However, the compounds of examples 16, 17, 19, 46 and 61 are all such that A is hydrogen and B is hydrogen. Hamori teaches the compounds

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where A forms together with B a valence bond and thus fails to exhibit the superior properties associated with these species. Hamori generically teaches the compounds of the instant invention where instant R^1 is $CO-(CH_2)_p-R^6$, p is 1 or 2 and R^6 is halo or alkoxy.

Claims 1, 5-9, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamori et al., WO 96/04283. For reasons of record and stated above.

4. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1-3, 5-7, 9, 10, 13, 14, 16 and 17 by András et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that the "present invention is patentable over the cited art as the present invention has superior and unexpected effects over the prior art compounds". However, the compounds of examples 16, 17, 19 and 46 are all such that instant R^1 is $-C(O)-NH$ -cyclopropyl, $-C(O)-NH-OMe$, $-C(O)-NH-NH_2$ or $-C(O)-NH-CH_2CH_2$ -morpholin-1-yl and thus fails to exhibit the superior properties associated with those species where R^1 is $-C(O)-(CH_2)_m$ -halo. András generically teaches the compounds of the instant invention where instant R^1 is $-C(O)-(CH_2)_m-R$ and R is a halo atom.

Claims 1-3, 5-7, 9, 10, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over András et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3, 6, 9, 11, 14, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 1 recites the limitation "C₁₋₁₄ alkyl" in the proviso labeled 4). There is insufficient antecedent basis for this limitation in the claim.
- b) Claim 3 recites the limitation "dimethylaminophenyl" in the definition of R³ and R⁴. There is insufficient antecedent basis for this limitation in the claim.
- c) Claim 3 is vague and indefinite in that it is not known what is meant by the proviso labeled 1) and the proviso labeled 2) where the compounds are not limited to R³ and R⁴ being C₁₋₂ alkyl which is excluded by the provisos of claims 1 and 2 from which claim 3 depends thus claim 3 is broader in scope than claims 1 and 2.
- d) Claim 3 is vague and indefinite in that it is not known what is meant by the proviso labeled 2) where when m has a value of 2..... The variable m can no longer be 2 in claim 3.
- e) Claim 6 recites the limitation "(methoxy-phenoxy)-(hydroxypropyl) group" in the definition of R⁷ and R⁸. There is insufficient antecedent basis for this limitation in the claim.

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- f) Claim 9 recites the limitation " C_{1-14} alkyl" in the proviso labeled 4). There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 11 recites the limitation "dimethylaminophenyl" in the definition of R^3 and R^4 . There is insufficient antecedent basis for this limitation in the claim.
- h) Claim 14 recites the limitation "(methoxy-phenoxy)-(hydroxypropyl) group" in the definition of R^7 and R^8 . There is insufficient antecedent basis for this limitation in the claim.
- i) Claim 16 recites the limitation " C_{1-14} alkyl" in the proviso labeled 3) and the proviso labeled 4). There is insufficient antecedent basis for this limitation in the claim.
- j) Claim 17 recites the limitation " C_{1-14} alkyl" in the proviso labeled 3). There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

6. Claims 4 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Applicants' attention is directed to U.S. Patent Numbers 5,639,751; 5,521,174; 5,519,019; 5,604,223; and 5,536,832, claims subject matter that is similar and/or identical to that

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claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
October 8, 2002